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EXAMINER

HESS, DANIEL A

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/922,330

Applicant(s)

KATO ET AL.

Examiner

Daniel A Hess

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-17 and 19-28 is/are rejected.
- 7) ☒ Claim(s) 5 and 18 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Receipt is acknowledged of an amendment dated 6/30/2003, which has been placed in the file of record, and to which this action is a reply.

Remarks

2. The rejections of claims 5 and 18 are withdrawn in view of what the applicant's arguments regarding these claims. Therefore, this action made non-final. Other arguments, made previously, remain, although as a result of amendment some 102 rejections are now 103 rejections. Note that the motivation re claims 1 and 2 is changed.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-4 and 6-17, 19-23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurita as applied to claim 1 above, and further in view of Madill et al. (US Des. 363932).

Re claims 1, 2 and 20: See especially figure 1 of Kurita. There is a remote controller (column 1, lines 5-10), wireless (infrared) transmission, and input by depressing at some position to control a TV or VCR (column 2, lines 63-68). There is a display portion that includes (figure 1) a card 18 that is interchangeable. The functionality of the remote can be altered by "*merely replacing the said operating cards... as needed*" (column 1, lines 64-65). Further, the control functionality depends both on the coordinates and the card that is identified (column 1, lines 50-57).

Kurita fails to teach that the changeable card is above the sensor input. Rather, in Kurita (column 1, lines 40-65) it is clear that although coordinates are taken, the display card is underneath the touch screen 10.

Madill shows (entire document) a multi-functional remote with a display for a remote input panel that is overlaid.

In view of Madill, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the old and well-known overlaid card of Madill instead of the underlying card of Kurita because the clear, touch-sensitive screen in Kurita is potentially more expensive and fragile than one that does not have to be clear.

Re claim 3: See Kurita, column 1, lines 40-65; entire document.

Re claims 4 and 11: As Kurita makes clear (column 6, lines 45-53; figure 9) identifying notches may be employed on the side of the card to indicate the type of card.

Re claim 6: A plurality of display cards is clearly indicated (see column 1, lines 40-65; throughout document).

Re claims 7 and 8: These claims represent simple shape permutations of the notches on the side of the card as discussed re claim 4 above (see column 6, lines 45-53; figure 9). The principle of equivalence (In Re Dillon, MPEP 2144) applies, where these shape permutations can be considered equivalent in the art. Further, this difference may be considered a simple shape variation. Using projections instead of grooves on the edge of the card, or a combination of both, and / or using numbers and / or positions of each are just shape variations on the idea expressed by Kurita et al.

Re claims 9 and 14: There is a case (figure 1), the case having a slot 14a (column 2, lines 52-56) for receiving the card.

Re claim 10: Kurita may or may not show employing opposite sides of a single card (column 6, lines 38-45); his discussion on the topic is brief.

In any event, printing on both sides of a sheet of paper instead of using two single-sided printings is old and well-known in the art. In view of this printing practice, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known double-sided printing idea in the function cards of Kurita because this can reduce the number of function cards for simplicity, and to reduce the risk of losing a card.

Re claim 11: See arguments re claim 4 above.

Re claim 12: The cards are shown to have in one embodiment (column 3, lines 1-10) a circuit completion structure.

Re claim 13: See discussion / arguments re claims 1-3 and 10 above.

Re claim 15: The use of optical means to read the cutout portion is not explicitly stated in Kurita.

It is however, old and well known from audiocassette tapes and floppy disks to employ a light beam to read cutout tabs indicating re-recordability. In view of this, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known optical means to read cutout portions because this is generally less prone to breakdown than mechanical means, which employ moving parts.

Re claim 16: Notches to indicate a card type are an example of indicia. A barcode is another type of indicia, and as long as the card type is conveyed, the device will work as required. Therefore, the principle of equivalence applies (In Re Dillon, MPEP 2144).

Re claim 17: The notches of figure 9 may be pressing against mechanical switches. Whether the notches interact with an optical means or with mechanical switches is not clear; nevertheless, both means to the end are equivalent in the art (In Re Dillon).

Re claim 19: A "touch panel" (column 2, line 51) can be considered an x-y contact pad.

Re claims 21-24: As Kurita makes clear (column 6, lines 45-53; figure 9) identifying notches may be employed on the side of the card to indicate the type of card. The principle of equivalence (In Re Dillon, MPEP 2144) applies, where these shape permutations can be considered equivalent in the art. Further, this difference may be considered a simple shape variation. Using projections instead of grooves on the edge of the card, or a combination of both, and / or using numbers and / or positions of each are just shape variations on the idea expressed by Kurita et al.

Re claim 25: There is a case (figure 1), the case having a slot 14a (column 2, lines 52-56) for receiving the card.

Re claim 27: The cards are shown to have in one embodiment (column 3, lines 1-10) a circuit completion structure.

Allowable Subject Matter

7. Claims 5 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The applicant's arguments re these claims are persuasive. In particular, while Funado (US 5,537,107), cited in the previous action, teaching sending data from a TV to the screen on a remote, Funado fails to show that the data going from the TV to the controller comprises an image of an interface for a touch-based input surface; rather it is a preview of what is displayed on the TV.

Nowhere else is the subject matter of claim 5 taught or suggest.

Response to Arguments

The examiner respectfully stands by the earlier statement that there is no 'functional' difference between having a keypad card above and below the touch-pad. Webster's defines function as purpose, and the purpose is the same in either case.

Many of the applicant's arguments are based on the fact that Madill lacks many features of the claimed invention. However, as a secondary reference, Madill need not capture fully the claimed invention. Madill is only used to show an overlay for a remote that occurs on the surface; all other aspects of the card-remote controller system can be drawn from Kurita.

That Madill has holes for buttons is not relevant in our case because Kurita doesn't have buttons. Madill is included for the singular purpose of teaching the concept of an overlaid card for a remote.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A Hess whose telephone number is (703) 305-3841. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

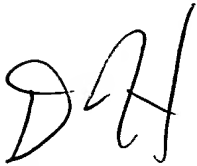
9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

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10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



DH
July 23, 2003

Daniel A Hess
Examiner
Art Unit 2876



THIEN M. LE
PRIMARY EXAMINER